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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,012	12/08/2005	Jean-Baptiste E. Blanc	PU4832USW	1078
23347 7590 01/22/2009 GLAXOSMITHKLINE CORPORATE INTELLECTUAL PROPERTY, MAI B482 FIVE MOORE DR., PO BOX 13398 RESEARCH TRIANGLE PARK, NC 27709-3398				
EXAMINER BASQUILL, SEAN M				
ART UNIT		PAPER NUMBER		
1612				
NOTIFICATION DATE		DELIVERY MODE		
01/22/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary**Application No.**

10/560,012

Applicant(s)

BLANC ET AL.

Examiner

Sean Basquill

Art Unit

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-46 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/88)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted:

- Group I, Claims 1-33, 35, 43 and 44, drawn to compounds and compositions containing compounds of formula I;
- Group II, Claims 42, 45, and 46 drawn to a method of treating osteoporosis using compounds of formula I;
- Group III, Claims 42, 45, and 46 drawn to a method of treating muscle wasting using compounds of formula I;
- Group IV, Claims 42, 45, and 46 drawn to a method of treating frailty using compounds of formula I;
- Group V, Claims 42, 45, and 46 drawn to a method of treating cardiovascular disease and atherosclerosis using compounds of formula I;
- Group VI, Claims 42, 45, and 46 drawn to a method of treating breast cancer using compounds of formula I;
- Group VII, Claims 42, 45, and 46 drawn to a method of treating uterine cancer using compounds of formula I;

- Group VIII, Claims 42, 45, and 46 drawn to a method of treating prostatic hyperplasia using compounds of formula I;
- Group IX, Claims 42, 45, and 46 drawn to a method of treating prostate cancer using compounds of formula I;
- Group X, Claims 42, 45, and 46 drawn to a method of treating dyslipidemia using compounds of formula I;
- Group XI, Claims 42, 45, and 46 drawn to a method of treating menopausal vasomotor conditions using compounds of formula I;
- Group XII, Claims 42, 45, and 46 drawn to a method of treating urinary incontinence using compounds of formula I;
- Group XIII, Claims 42, 45, and 46 drawn to a method of treating libido enhancement using compounds of formula I;
- Group XIX, Claims 42, 45, and 46 drawn to a method of treating depression using compounds of formula I;
- Group XX, Claims 42, 45, and 46 drawn to a method of treating uterine fibroid disease using compounds of formula I;
- Group XXI, Claims 42, 45, and 46 drawn to a method of treating aortic smooth muscle cell proliferation using compounds of formula I;
- Group XXII, Claims 42, 45, and 46 drawn to a method of treating endometriosis using compounds of formula I;
- Group XXIII, Claims 42, 45, and 46 drawn to a method of treating ADAM using compounds of formula I;

As set forth in Rule 13.1 of the Patent Cooperation Treaty (PCT), "the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." Moreover, as stated in PCT Rule 13.2, "where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features." Furthermore, Rule 13.2 defines "special technical features" as "those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art."

3. The inventions listed as Groups I- XXIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of Group I is a compound of Formula I, such as para-amino benzoic acid. The compound of Formula I of claim 1 does not present a contribution over the prior art. As disclosed in the Sigma Chemical Catalog from 1989, page 217, the compound of Formula I of instant claim 1 is anticipated. As such, Group I does not share a special technical feature with the instant claims of Groups II- XXIII. Therefore, the claims are not so linked within the meaning of PCT Rule 13.2 so as to form a single inventive concept, and unity between Groups I- XXIII is broken.

4. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of

the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Election of Species

5. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

If Group I is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claim groups 1-28, 29, and 30-33. To be clear, one compound from each set of claims previously outlined must be elected for a response to this action to be fully responsive.

If Group II is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group III is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group IV is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group V is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group VI is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group VII is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group VIII is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group IX is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group X is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group XI is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group XII is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group XIII is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group XIV is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group XV is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group XVI is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group XVII is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group XVIII is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group XIX is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group XX is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group XXI is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group XXII is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

If Group XXIII is elected, the following species election is required:

- *Core compound with multiple R groups*: one compound species of formula (I) as recited by claims 42, 45, and 46. To be clear, one compound representing each claim must be elected for a response to this action to be fully responsive.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. Upon Applicant's election of species, the result must provide a single chemical compound for each group as outlined above. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Basquill whose telephone number is (571) 270-5862. The examiner can normally be reached on Monday through Thursday, between 8AM and 6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Sean Basquill
Art Unit 1612

/Brandon J Fetterolf/
Primary Examiner, Art Unit 1642